

Attorney Docket No.: PENN-0754  
Inventors: Scott L. Diamond  
Serial No.: 09/763,982  
Filing Date: April 25, 2001  
Page 2

#### REMARKS

Claims 1-14 are pending in the instant application. The pending claims have been subjected to a Restriction Requirement as follows:

Group I, claims 1-13, drawn to a compound comprising a nuclear targeting peptide and a nonclassical nuclear localization signal, and a first method of use, classified in 435, subclass 375;

Group II, claim 14, drawn to a second method of using a compound comprising a nuclear targeting peptide and a nonclassical nuclear localization signal.

The Examiner suggests that Groups I and II as set forth above are distinct, each from the other, because they lack the same or corresponding special technical features. It is suggested that the technical feature linking the groups is a compound comprising a nuclear targeting peptide and a nonclassical nuclear localization signal. The Examiner suggests that the technical feature cannot be considered special under the PCT Rule 13.2 because it is suggested to lack contribution over prior art, namely Thatcher et al. WO96/41606 which purportedly teaches a composition comprising a cationic peptide scaffold and the nonclassical nuclear localization targeting peptide encoded by SEQ ID NO:3 of the instant invention.

Attorney Docket No.: PENN-0754  
Inventors: Scott L. Diamond  
Serial No.: 09/763,982  
Filing Date: April 25, 2001  
Page 3

Applicant respectfully traverses this restriction requirement.

MPEP §803 is quite clear; for a proper restriction requirement, it must be shown (1) that the inventions are independent or distinct AND (2) that there would be a serious burden on the Examiner if the restriction is not required. MPEP 802.01 defines "distinct" to mean that the "two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made there, etc., but are capable of separate manufacture, use, or sale, as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER."

All of claims of the instant application relate to the concept of a nuclear targeting peptide (NTP), comprising a peptide sequence containing a nonclassical, nuclear localization signal (NLS). Accordingly, each of the claims contain the same components for use in the same endpoint - use of a nuclear targeting peptide in compositions. In further illustration of the relationship of the inventions, claim 14 (of Group II) recites the composition administered to a patient as being the composition of claim 9 (of Group I). Thus, Applicant respectfully disagrees that the Groups set forth by the Examiner are distinct as being novel and unobvious over each other, as required by MPEP § 802.01.

Attorney Docket No.: PENN-0754  
Inventors: Scott L. Diamond  
Serial No.: 09/763,982  
Filing Date: April 25, 2001  
Page 4

Further, a search of literature relating to nuclear targeting peptides would clearly reveal art relating to both of these Groups. Thus, the inclusion of both Groups in this application would not be overly burdensome to the Examiner. Accordingly, the instant Restriction Requirement meets neither of the criteria as set forth by MPEP §803 to be proper.

In addition, the Examiner seems to be suggesting that this invention lacks novelty over prior art as a consideration for restriction. As clearly recited in the MPEP § 806.01, patentability over prior art may not be considered for the question of restriction. For the purposes of a decision on the question of restriction, claims are to be assumed to be in proper format and patentable (novel and unobvious) over prior art. It is only after the question of restriction is settled that the question of patentability of the several claims in view of the prior art may be taken up.

Accordingly, reconsideration and withdrawal of this Restriction Requirement is therefore respectfully requested.

Attorney Docket No.: PENN-0754  
Inventors: Scott L. Diamond  
Serial No.: 09/763,982  
Filing Date: April 25, 2001  
Page 5

However, in an earnest effort to be completely responsive,  
Applicant elects Group I, claims 1-13 with traverse.

Respectfully submitted,

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